



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/596,860

03/14/2007

Robert Douglas

3869/038 US

1439

23440

7590

10/12/2010

GOTTLIEB RACKMAN & REISMAN PC

270 MADISON AVENUE

8TH FLOOR

NEW YORK, NY 10016-0601

EXAMINER

MATTER, KRISTIN CLARETTE

ART UNIT

PAPER NUMBER

3771

MAIL DATE

DELIVERY MODE

10/12/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/596,860

**Applicant(s)**

DOUGLAS ET AL.

**Examiner**

KRISTEN C. MATTER

**Art Unit**

3771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 September 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19, 22, 23, 30-38, 40, 43-48, 50, 53, 54, 61-69, 71 and 74-79 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19, 22, 23, 30-38, 40, 43-48, 50, 53, 54, 61-69, 71, and 74-79 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-840)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This Action is in response to the amendment filed 9/14/2010. Claims 19, 34, 50, and 65 were amended, claims 20, 21, 24-29, 39, 41, 42, 49, 51, 52, 55-60, 70, 72, and 73 were cancelled and no claims were added. Thus, claims 19, 22, 23, 30-38, 40, 43-48, 50, 53, 54, 61-69, 71, and 74-79 are currently pending in the instant application.

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the **finality of that action is withdrawn.**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 19, 22, 23, 30-38, 40, 43-48, 50, 53, 54, 61-69, 71, and 74-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Froehlich et al. (US 5,551,419, herein referred to as "Froehlich") in view of Berthon-Jones (US 5,704,345) and Hill (US 2002/0088465).**

Regarding claims 19, 34-38, 43, 50, 54, 65-69, and 74, Froehlich discloses CPAP apparatus having a blower (12), a patient interface (11), an air delivery conduit (14), a pressure sensor (16), a flow sensor (15), an air synchrony module to determine transitions between inhalation and exhalation (see column 2, lines 60-65 and column 6, lines 15-20 for example), and a control mechanism (17) programmed to provide positive pressure in accordance with a

predetermined pressure-time template (see Figure 4). Froehlich further discloses that the apparatus controls blower operation by automatically determining the presence of sleep disordered breathing and automatically determining a treatment pressure in accordance with the presence of sleep disordered breathing (column 5, lines 35-55), setting at least one characterizing parameter of the pressure-time template to the treatment pressure (column 6, lines 15-27 and column 13, lines 20-30), and controlling the blower to delivery a supply air in accordance with the template and in synchrony with the patient's breathing cycles (via lines 19 and 20).

Froehlich discloses determining sleep disordered breathing, such as apnea, from "known techniques" but does not specifically mention an index. However, indices are well known and commonly used in the art for determining the presence of a sleep disordered breathing event. In addition, Berthon-Jones discloses a similar CPAP apparatus that determines the presence of apneas by calculating several indices, including both an index for indicating apnea and an index indicative of flow flattening (see abstract). The index for calculating apnea is determined from a ratio of the middle points (column 10, lines 35-40), while the flow flattening index is calculated from the root mean square deviation (column 11, lines 3-7). Thus, the first and second indices are considered as being determined from "different characteristics" of the signals. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used several indices for determining the presence of sleep disordered breathing in the system of Froehlich because it would have allowed a user to use a well known means for determining the presence and/or severity of sleep disordered breathing and to provide therapy as needed. Such a modification would involve the mere substitution of a well known method of

determining apnea episodes in a well known device to yield predictable results that do not patentably distinguish an invention over the prior art.

Froehlich as modified by Berthon-Jones further lacks setting one pressure parameter to a first treatment pressure in accordance with the first index during expiration and another pressure parameter to a second treatment parameter based on the second index during inspiration. However, Hill discloses a similar CPAP apparatus that uses several indices to vary both the IPAP and EPAP to counter a sleep disordered breathing event (see paragraphs 11, 12, 49, and 53 for example). Hill further discloses in paragraph 53 that while it is always necessary to adjust the IPAP pressure, sometimes it is necessary to also adjust the EPAP when IPAP adjustments are not enough to treat the patient. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have further modified Froehlich to adjust both the EPAP and IPAP as taught by Hill depending on the severity of the sleep disordered breathing event and/or to treat the patient more comfortably by adjusting both the minimum and maximum pressures only as necessary. Either the indices of Hill, which are determined from different characteristics (i.e., peak flow) than those of Berthon-Jones, could be used solely for EPAP adjustment while Berthon-Jones are used for IPAP adjustment or Berthon-Jones's indices could be used individually for IPAP and EPAP since Berthon-Jones discloses that the indices may be used individually (column 11, lines 19-23). Furthermore, there is nothing structurally in Froehlich that would prevent the controller from adjusting both the EPAP and IPAP based on the indices and it appears as though Froehlich would perform equally well with both the EPAP and IPAP being adjusted.

Regarding claims 22, 44, 53, and 75, Froehlich discloses the template can be a square wave (see column 2, line 64).

Regarding claims 30, 40, 61, and 71, Froehlich does not specifically disclose a maximum swing/pressure difference. However, absent a critical teaching and/or showing of unexpected results from having a maximum swing, examiner contends that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a maximum swing in order to prevent the swing from getting too large if a high number of sleep disorder breathing events was detected, to increase comfort to the patient by keeping the maximum and minimum pressure levels closer to one another, and to allow the device to effectively get to the desired min/max pressure levels (i.e., if the swing is too large the system might not be able to reach the desired pressures in the given amount of time of the breathing cycle). In addition, since the pressures are generally between 3-20 cmH2O in CPAP systems, it would have been obvious to ensure that the pressures stayed within this range, and thus are subject to a maximum swing. Furthermore, there is nothing structurally that would prevent the use of a maximum swing and it appears as though the device would work equally well with a maximum swing when increasing/decreasing the pressure.

Regarding claims 31, 32, 47, 48, 62, 63, 78, and 79, Froehlich, Berthon-Jones, and Hill all disclose decreasing pressures in the absence of sleep disordered breathing events (see column 1, lines 55-60 of Froehlich and paragraphs 13, 51, 69, 72, and 75 of Hill for example). It thus would have been obvious to adjust the first and second treatment pressures in accordance with the absence of events determined by their respective indices.

Regarding claims 33, 46, 64, and 77, Froehlich does not specifically mention a look-up table. However, the controller is programmable and look-up tables and arrays are well known and commonly use processing techniques for creating signals. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have had the breathing signal be derived from a look-up table or array because it would have provided a well known means of creating a safe breathing profile for a user. Such a modification would appear to involve the mere substitution of a well known method in a well known device to yield predictable results that do not patentably distinguish an invention over the prior art.

Regarding claims 45 and 76, Froehlich lacks the template being a shark-fin wave. However, shark-fin waves are well known and commonly used in CPAP systems as evidenced by Hill (see Figure 4 for example). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a shark-fin wave in the template of the modified Froehlich device in order to more comfortably delivery gas to a patient by making pressure changes less abrupt for example. Furthermore, there is nothing structurally preventing the use of a shark-fin wave (or any other well known waveform for that matter) in Froehlich's system and it appears as though Froehlich would perform equally well with a shark-fin wave. Such a modification would involve the mere substitution of a well known method/waveform in a well known device to yield predictable results that do not patentably distinguish an invention over the prior art.

***Response to Arguments***

Applicant's arguments filed 9/14/2010 have been fully considered but they are not persuasive.

Regarding applicant's arguments on the cited references either teaching setting one treatment level (with two indices) or two levels based on a single sourced event, examiner notes that the rejection is an obviousness rejection. Berthon-Jones teaches determining indices from different characteristics of the flow patterns as discussed above but only adjusts IPAP. The two indices can be used together to determine the severity of the sleep disordered breathing, or they may be used individually (column 11, lines 10-30). Hill then teaches the use of several indices for adjusting both IPAP and EPAP because sometimes it is necessary to adjust both when adjustment of IPAP is not enough (paragraph 53). It is the examiner's position that looking at the teachings of those references it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Froehlich's device to use the two indices disclosed by Berthon-Jones for determining the presence of sleep apnea, and then to adjust the EPAP in addition to the IPAP as taught by Hill using one of the indices of Berthon-Jones because Hill teaches that adjustment of EPAP in addition to IPAP may be necessary for a more severe sleep disordered breathing event and/or to treat the patient more comfortably by adjusting both the minimum and maximum pressures only as necessary. In the alternative, examiner maintains that one of ordinary skill in the art could use the two indices of Berthon-Jones for controlling IPAP and the indices of Hill for controlling EPAP in the modified Froehlich device. In such a case, the indices are clearly determined differently and used independently of one another.



Applicant further argues that Hill is solely used for treatment of CSR and not apneas. However, Hill discloses treatment of sleep apnea in the abstract, throughout the background section, and in paragraphs 11 and 47 for example. Thus, it appears that Froehlich's device would work equally well with the methods of Hill, either by use of Hill's index calculations themselves for adjusting EPAP or at a minimum Hill's teaching that adjustment of EPAP in addition to IPAP is sometimes necessary (i.e., using only Berthon-Jones's indices, for example).

### ***Conclusion***

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the **finality of that action is withdrawn**.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTEN C. MATTER whose telephone number is (571)272-5270. The examiner can normally be reached on Monday - Friday 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tatyana Zalukaeva/  
Supervisory Patent Examiner, Art Unit 3761

/Kristen C. Matter/  
Examiner, Art Unit 3771